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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,225	01/29/2002	James W. Falciglia	01082-010006	5655
26171	7590	06/09/2004	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			NGUYEN, CHAU N	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/058,225

Applicant(s)

FALCIGLIA ET AL.

Examiner

Chau N Nguyen

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-48 and 52-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-48, 52-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Reissue Applications

Claim Objections

1. Claim 59 is objected to because of the following informalities: in claim 59, line 2, change "the" to --an-- and line 3, change "an", first occurrence, to --the--.
- Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.
- Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 45-48, 52-57, 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waterman (769,366) in view of GB 1,117,862 (GB'862).

5. Waterman discloses a conductive sheath and an inherent method, comprising forming a length of overlapping, helically wound conductive sheath, the conductive sheath (Figs 1-3) having an outer surface having an appearance.

Waterman does not disclose after the forming, applying a coating to the outer surface of the sheath, the coating having an appearance different from the appearance of the outer surface of the sheath, nor the sheath being used for housing conductors. GB'862 discloses a conductive sheath (4) having an appearance and a coating (5) having an appearance different from the appearance of the outer surface of the sheath. It would have been obvious to one skilled in the art to modify the conductive sheath of Waterman by applying, after the forming, a coating (5) as taught by GB'862 on the outer surface of the sheath to provide a distinguishing mark on the cable. It would also have been obvious to one skilled in the art to use the conductive sheath of Waterman for housing conductors since the sheath of Waterman is flexible and since using a conductive sheath for housing conductors is known in the art. In addition, it has been held that a recitation of the intended use

of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963) (re claims 45, 52, 60).

The modified sheath of Waterman (see GB'862, Figs 1-4) also discloses the coating being continuous along at least a portion of the sheath (re claims 46, 53), the coating being continuous around the circumference of the sheath (re claims 47, 54), the coating permitting electrical conductivity between successive windings of the sheath (i.e., the successive windings of Waterman are interlocked before the coating being applied, therefore the successive windings are still in electrical contact after the coating being applied) (re claims 48, 55), the outer surface of the sheath being provided with alternating crowns and valleys along the length of the sheath (re claim 56), the crowns and valleys forming a helical configuration on the outer surface of the sheath (re claim 57), and no further process being performed that would cover the applied coating (re claim 59).

6. Claims 52 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brorein (4,154,976) in view of GB'862.

Brorein discloses a conductive sheath and an inherent method, comprising forming a length of continuous conductive tubular sheath (18) for housing conductors, wherein the conductive sheath has an outer surface having an appearance and being smooth along the length of the sheath (re claim 58). Brorein does not disclose after the forming, applying a coating to the outer surface of the sheath, the coating having an appearance different from the appearance of the outer surface of the sheath (re claim 52). GB'862 discloses a conductive sheath (4) having an appearance and a coating (5) having an appearance different from the appearance of the outer surface of the sheath. It would have been obvious to one skilled in the art to modify the conductive sheath of Brorein by applying, after the forming, a coating (5) as taught by GB'862 on the outer surface of the sheath to provide a distinguishing mark on the cable.

Response to Arguments

Applicant's arguments filed May 10th 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that why one of ordinary skill in the art would want to "provide a distinguishing mark on the cable", it is very well-known in the art that providing a distinguishing mark on a cable is for the identification purpose. It is not necessary for the Office Action to further state that providing a distinguishing mark on the cable is "for the identification purpose".

In response to applicant's argument that there is no suggestion to combine the Waterman and GB'862 references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so is found in the references themselves. Specifically, GB'862 does teach providing a coating having a difference appearance from the outer surface of a conductive sheath to provide a distinguishing marker on the sheath.

In response to applicant's arguments that GB'862 teaches placing marker on each individual conductor and not on the outer surface of a cable, the test for obviousness is not whether the features of a secondary reference may be bodily

incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Summary

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Chau N Nguyen
Primary Examiner
Art Unit 2831